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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

3622

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,950

Applicant(s)

MILLER ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Support of Registered Attorney or Agent

1. While an inventor may prosecute the application, it is the USPTO's experience that lack of prosecution experience usually acts as a liability in affording the maximum protection for the invention disclosed. The Office recommends that applicant consider securing the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution.
2. The following sources are available for selecting an Attorney or agent.
 - (A) Applicant can search the roster of attorneys and agents at the Office's home page, <http://www.uspto.gov>. Click on "Site Index" at the top of the home page. Then, in the alphabetical list, click on "Agent and Attorney Roster". Then click on "Attorney/Agent Search".
 - (B) Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

MPEP

3. All the US patent laws and rules of examination are in the *Manual of Patent Examining Procedure*, 8th edition, which is available through the Office's web site, <http://www.uspto.gov>. Click on "Site Index" at the top of the home page. Then, in the alphabetical list, click on "Manual of Patent Examining Procedure (MPEP) Information Page". The next page gives instructions for viewing individual chapters and parts of the Appendix in .pdf format and for purchasing a paper copy of the MPEP.

Certificate of Mailing

4. It is called to applicant's attention that if a communication is deposited with the U. S. Postal Service and mailed to the Office by First Class Mail before the reply time has expired, applicant may submit the reply with a "Certificate of Mailing" which merely asserts that the

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reply is being mailed on a given date. So mailed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
on _____ (date).

Typed or printed name of person signing this certificate

Signature _____

Date _____

Additional useful information on communicating with the Office is contained in 37 CFR 1.10 (*Patent Rules, Appendix R of the MPEP*).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 6, 7, 15 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts - i.e., no computer implementation or any other technology is employed.
7. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and

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the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

8. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).
9. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

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10. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (Bd. Pat. App. & Int. 2001).

Claim Rejections - 35 USC § 102 and 35 USC § 103

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 6-8, 13-15 and 20 are rejected under 35 U.S.C. 102(b)/102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over LeMole et al. (US006009410A). The rejection is tentatively under 35 U.S.C. 102(b) based on the filing date of the application, or under 35 U.S.C. 102(e) based on the filing date of the parent application 09296749, subject to a search of the parent application for the claimed matter.
14. LeMole et al. teaches (independent claims 1, 8 and 15) a method, computer program product and system for distributing targeted sales information, the method comprising the steps of: (a) storing user input relating to products (e.g., *automobiles* in Fig. 2) in a database (*database 112*, col. 4 lines 36-47); (b) receiving a (user) request to send *advertising*, which is sales information associated with a product (col. 3 line 66 to col. 4 line 3); [(c) and (d)] searching *database 112* for the profile of the user requesting the advertising/sales information, and outputting the advertising/sales information to the selected/requesting user (col. 4 lines 23-35).
15. LeMole et al. does not explicitly teach (e) charging a fee for outputting the advertising/sales information. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the process of distributing/outputting the advertising/sales information is itself a costly service that could not generally be done freely. The reference (col. 4 lines 4-10) teaches providing incentives to the user for requesting the advertising. Someone must inherently be paying for these incentives, and that is generally the advertiser who also pays the fee charged for outputting the sales information. Alternatively, because advertisers are willing to pay for the distribution/outputting of their advertising/sales information, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add charging a fee for outputting the advertising/sales information to the teachings of LeMole et al.

16. LeMole et al. also teaches claims 6, 7, 13, 14 and 20 where *providing information relating to the Web sites visited by the user* (col. 5 lines 27-28) reads on tracking the user response to the sales information, and providing access to the Web page of the promoter (advertiser) of a product (col. 2 lines 43-46) allows said promoter/advertiser to provide dynamic feedback to a user.
17. Claims 4-5, 11-12 and 18-19 are rejected under 35 U.S.C. 103(a) as obvious over LeMole et al.
18. LeMole et al. does not teach (claims 4, 11 and 18) that the client device is a PC. Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, for users to have PCs. Because it would be convenient for customers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of LeMole et al. that the client device is a PC.
19. LeMole et al. does not teach (claims 5, 12 and 19) that additional fees are charged for outputting the sales information to portable devices. Because it would be convenient to receive said information at a portable device, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of LeMole et al. that additional fees are charged for outputting the sales information to portable devices.
20. Claims 2, 9 and 16 are rejected under 35 U.S.C. 103(a) as obvious over LeMole et al. in view of Sloane (US005918211A). LeMole et al. does not teach that the user input includes representations of bar codes associated with products. Sloane et al. teaches user inputs that representations of bar codes associated with products (col. 3 lines 12-15). Because this would permit customers to get detailed information on specific products at point of purchase, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Sloane to those of LeMole et al.
21. Claims 3, 10 and 17 are rejected under 35 U.S.C. 103(a) as obvious over LeMole et al. in view of Davis et al. (US20010042064A1). LeMole et al. does not teach that that an additional fee is charged for selecting a positioning of the advertising/sales information on the Web page. Davis et al. et al. teaches that an additional fee is charged for selecting a positioning of the advertising/sales information on the Web page. (para. [0027]). Because

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this make the invention more profitable, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Davis et al. to those of LeMole et al.

Special Note for Applicant Pro se¹

22. In this Office action the examiner has judged the claims on their face (prima facie) to be non-patentable, because they are taught by or obvious over certain "prior art". If applicant disagrees with the examiner's judgment, applicant should respond by filing arguments explaining, as precisely as possible, where the rejection above is wrong. In doing so applicant should recognize that the entire reference is available to support the rejection, not just the sections cited above by the examiner. Applicant should also recognize that MPEP § 2111 and 2111.01 require the examiner to give claims language its "broadest reasonable interpretation" unless applicant has provided a "clear definition" of the terms in the specification. Hence, if applicant believes the examiner's implicit interpretation is wrong, applicant should explain where a "clear definition" of the term(s) appears in the specification.
23. Applicant may also amend the claims to overcome the rejection. Applicant can do so in the current application only if the amending matter is presented in the current application. A "new matter" rejection will result if the examiner cannot find the material in the specification. Hence, it is to applicant's advantage to applicant to point out in the reply where in the disclosure the amending material appears. Amendments must be made consistent with the requirements of 37 CFR § 1.52, which is in Appendix R of the MPEP cited above.
24. Applicant is entitled to contact the examiner to schedule a half-hour "interview" with the examiner to discuss the application, which may be done by telephone or in person, as applicant chooses.

Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and

¹ An applicant representing him or her self, without a patent attorney or agent.

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informal fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.

26. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

27. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne
Examiner
Art Unit 3622

12 June 2004